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09/713,962	11/15/2000	Alain T. Rappaport	MS320512.02/MSFTP1835USA	5197

  

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EXAMINER	
FRENEL, VANEL	

  

ART UNIT	PAPER NUMBER
3627	

  

NOTIFICATION DATE	DELIVERY MODE
09/14/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/713,962	RAPPAPORT ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Vanel Frenel	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 3/19/07.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/19/07 has been entered.

### **Notice to Applicant**

2. This communication is in response to the RCE filed on 3/19/07. Claims 1, 8, 12 and 21 have been amended. Claims 22 -23 have been newly added. Claims 1-23 are pending.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 8-10 and 12-13 and 15-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montlick (5,561,446) in view of Lavin et al (5,772,585).

As per claim 1, Montlick discloses a method of communicating healthcare information, the method comprising: displaying a set of codes each corresponding to a respective healthcare data, "the healthcare data including a plurality of medical

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diagnoses each of which corresponds to at least one code (See Montlick, Col.5, lines 49-67); storing the set of codes (See Montlick, Col.10, lines 6-30); detecting selection by a user of a subset of the displayed codes that corresponds to a medical diagnosis relevant to a patient (See Montlick, Col.5, lines 49-67 to Col.6, line 7).

Montlick does not explicitly disclose that the method having the medical diagnoses in a memory a portable terminal; and wirelessly transmitting the selected subset of the displayed codes from the portable terminal to a server system via a first network capable of providing communication between the portable terminal and the server system, wherein said wirelessly transmitting causes the healthcare data corresponding to the selected subset of the displayed codes to be provided to a medical patient via a second network capable of providing communication between the server system and a patient accessible device.

However, these features are known in the art, as evidenced by Lavin. In particular, Lavin suggests that the method having the medical diagnoses in a memory a portable terminal (See Lavin, Col.4, lines 33-67); and wirelessly transmitting the selected subset of the displayed codes from the portable terminal to a server system via a first network capable of providing communication between the portable terminal and the server system (See Lavin, Col.4, lines 33-67), wherein said wirelessly transmitting causes the healthcare data corresponding to the selected subset of the displayed codes to be provided to a medical patient via a second network capable of providing communication between the server system and a patient accessible device (See Fig.1; Col.13, lines 29-59).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Lavin within the system of Montlick with the motivation of providing a method for concurrently recording examination and diagnoses notes in a database during patient examination (See Lavin, Col.1, lines 58-62).

As per claim 2, Lavin discloses the method wherein the portable terminal is a cellular telephone having on board memory (Lavin, Col.4, lines 43-59; Col.5, lines 19-27), the set of codes being one of an ICD-9CM diagnosis code, an ICD-10CM diagnosis code (See Lavin, Col.13, lines 29-44).

The motivation for combining the respective teachings of Montlick and Lavin are as discussed above in the rejection of claim 1, and incorporated herein.

As per claim 3, Montlick discloses the method wherein the code is transmitted via a first, wireless network (See Montlick, Col.5, lines 10-20).

As per claim 4, Montlick discloses the method of claim 3 wherein the first, wireless network is one of a CDMA network, a GSM network, a TDMA network and a CPDP network (The Examiner understands that Montlick teaches a spread-spectrum wireless network which has the same performance and usage in a digital cellular phone. In other words, the spread-spectrum is equivalent to the CDMA network that Applicant's is referring to. See Col.5, lines 10-20).

As per claim 5, Montlick discloses the method wherein the recipient is a gateway that connects the first, wireless network to a second network (See Montlick, Col.3, lines 14-16).

As per claim 6, Montlick discloses the method wherein the second network comprises the Internet/World Wide Web (The Examiner interprets central computer 10 coupled to a modem 11 for communicating with other networks and/or for the transmission and reception of FAX information is a form of Internet/World Wide Web See Montlick, Col.5, lines 5-20).

As per claim 8, Montlick discloses the method wherein the healthcare data corresponding to the transmitted code is associated with corresponding healthcare information in a database, and wherein said corresponding healthcare information is transmitted to an end user via the second network (See Montlick, Col.3, lines 14-67).

As per claim 9, Montlick discloses apparatus for communicating healthcare information, the apparatus comprising:

a portable terminal to communicate wirelessly with a server system via a first, wireless network (See Montlick, Col.3, lines 10-36);

a memory, associated with the portable terminal, to store a set of codes and medical diagnoses, each code corresponding to a medical diagnosis relating to healthcare data (See Montlick, Col.10, lines 6-30);

a display to display the set of codes and the medical diagnoses (See Montlick, Fig.2; Col.5, lines 54-61);

a selector operable by a user to select desired codes of the set of codes for transmission to the server system, the desired codes identifying a medical condition (See Montlick, Col.9, lines 37-47).

Montlick does not explicitly disclose that the apparatus wherein transmission of the desired codes causes corresponding healthcare data to be provided to a medical patient via a second network, wherein the second network is adapted to provide communication between the server system and a patient accessible device.

However, this feature is known in the art, as evidenced by Lavin. In particular, Lavin suggests that the apparatus wherein transmission of the desired codes causes corresponding healthcare data to be provided to a medical patient via a second network, wherein the second network is adapted to provide communication between the server system and a patient accessible device (See Fig.1; Col.13, lines 29-59).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Lavin within the system of Montlick with the motivation of providing a method for concurrently recording examination and diagnoses notes in a database during patient examination (See Lavin, Col.1, lines 58-62).

As per claim 12, Montlick discloses a system for communicating healthcare information, the system comprising:

at least one portable terminal to communicate wirelessly with a gateway via a first, wireless network, the portable terminal including a memory associated therewith for storing a set of codes, and medical diagnoses, each code corresponding to respective healthcare data including medical diagnoses (See Montlick, Col.10, lines 6-30);

a display for displaying the set of codes and the medical diagnoses, each code identifying a medical diagnosis (See Montlick, Fig.2; Col.5, lines 54-61); and

a first server to communicate with the gateway device and to communicate healthcare information to a second user via a second network (See Montlick, Col.3, lines 14-67).

Montlick does not explicitly disclose a selector operable by a first user to select a set of the codes in connection with formulating a comprehensive medical diagnosis for transmission to the recipient; wherein the healthcare information is related to the corresponding set of codes; wherein the gateway device is capable of facilitating communication between said at least one portable terminal and the first server.

However, this feature is known in the art, as evidenced by Lavin. In particular, Lavin suggests a selector operable by a first user to select a set of the codes in connection with formulating a comprehensive medical diagnosis for transmission to the recipient (See Lavin, Col.13, lines 29-59); wherein the healthcare information is related to the corresponding set of codes (See Lavin, Col.13, lines 29-59); wherein the gateway device is capable of facilitating communication between said at least one portable terminal and the first server (See Lavin, Col.4, lines 43-59).



It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Lavin within the system of Montlick with the motivation of providing a method for concurrently recording examination and diagnoses notes in a database during patient examination (See Lavin, Col.1, lines 58-62).

As per claim 17, Montlick discloses the system further comprising a second, application server with an associated database storing healthcare information associated with the codes, the gateway being arranged to communicate with the first server via the application server, thereby to retrieve healthcare information from the database corresponding to receive codes and to transmit the healthcare information to an end user via the second network (See Montlick, Col.3, lines 14-67).

As per claim 18, Montlick discloses a system for communicating healthcare information, the system comprising:

a gateway device to communicate wirelessly with at least one portable terminal via a first, wireless network and with a first server (See Montlick, Col.3, lines 13-31), to receive codes from said at least one portable terminal selected from a set of codes each corresponding to respective healthcare data, and to transmit healthcare information corresponding to the received codes to the first server (See Montlick, Col.5, lines 21-67).

Montlick does not explicitly disclose a first server to communicate with the gateway device, to receive the healthcare information from the gateway device and to

communicate the healthcare information to a patient on which diagnosis was performed via a second network; wherein the second network is capable of providing communication between the first server and a patient accessible device.

However, these features are known in the art, as evidenced by Lavin. In particular, Lavin suggests that a first server to communicate with the gateway device, to receive the healthcare information from the gateway device and to communicate the healthcare information to a patient on which diagnosis was performed via a second network (See Lavin, Col.13, lines 1-41); wherein the second network is capable of providing communication between the first server and a patient accessible device (See Lavin, Col.15, lines 1-41).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Lavin within the system of Montlick with the motivation of providing a method for concurrently recording examination and diagnoses notes in a database during patient examination (See Lavin, Col.1, lines 58-62).

As per claim 21, Montlick discloses a machine-readable medium comprising instructions which, when executed by a machine, cause the machine to perform operations comprising: generating a display of a set of codes and medical diagnoses on a portable terminal, each code corresponding to respective healthcare data, the healthcare data including the medical diagnoses each of which corresponds to at least one code (See Montlick, Col.5, lines 10-20).

Montlick does not explicitly disclose detecting selection of a subset of the codes that correspond to a comprehensive medical diagnoses of patient; and wirelessly transmitting the selected subset of codes to a server system via a first network capable of providing communication between the portable terminal and a server system, wherein said wirelessly transmitting the subset of codes causes at least some of the medical diagnoses to be provided to the patient via a second network capable of providing communication between the server system and a patient accessible device.

However, these features are known in the art, as evidenced Lavin. In particular, Lavin suggests detecting selection of a subset of the codes that correspond to a comprehensive medical diagnoses of patient (See Lavin, Col.13, lines 29-59); and wirelessly transmitting the selected subset of codes to a server system via a first network capable of providing communication between the portable terminal and a server system, wherein said wirelessly transmitting the subset of codes causes at least some of the medical diagnoses to be provided to the patient via a second network capable of providing communication between the server system and a patient accessible device (See Lavin, Col.13, lines 29-59).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Lavin within the system of Montlick with the motivation of providing a method for concurrently recording examination and diagnoses notes in a database during patient examination (See Lavin, Col.1, lines 58-62).

As per claim 22, Montlick discloses an apparatus, comprising: a memory that stores a codes that respectively correspond to medical diagnosis (See Montlick, Col.10, lines 6-30); a processor that provides for displaying the codes on a display (See Montlick, Fig.5; Col.10, lines 38-63); wherein the apparatus wirelessly transmits the selected subset of codes to a network so that the patient can access the comprehensive medical diagnosis form a remote location (See Montlick, Col.9, lines 38-67).

Montlick does not explicitly disclose that a selector that receives selections from a doctor of a subset of the codes in connection with formulating a comprehensive medical diagnosis in connection with a patient, wherein the apparatus wirelessly transmits the selected subset of codes to a network so that the patient can access the comprehensive medical diagnosis form a remote location.

However, this feature is known in the art, as evidenced by Lavin. In particular, Lavin suggests that a selector that receives selections from a doctor of a subset of the codes in connection with formulating a comprehensive medical diagnosis in connection with a patient (See Lavin, Col.13, lines 29-59).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Lavin within the system of Montlick with the motivation of providing a method for concurrently recording examination and diagnoses notes in a database during patient examination (See Lavin, Col.1, lines 58-62).

As per claim 23, Montlick discloses a computer-implemented method that facilitates conveying medical information, comprising: wirelessly receiving a set of codes, selected by a doctor in connection with formulating a medical diagnosis of a patient (See Montlick, Col.9, lines 38-67); making the medical diagnosis report available to a third party over the Internet (The Examiner understands prescription which can be immediately transmitted to the pharmacy through the wireless network 13, or through the modem 11 (Fig.1) either as a computer file or as a FAX as a form of a transmission to a third party over the Internet See Montlick Col.10, lines 1-5).

Montlick does not explicitly disclose analyzing the set of codes, and generating a medical diagnosis report.

However, this feature is known in the art, as evidenced by Lavin. In particular, Lavin suggests analyzing the set of codes, and generating a medical diagnosis report (See Lavin, Col.13, lines 29-59).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Lavin within the system of Montlick with the motivation of providing a method for concurrently recording examination and diagnoses notes in a database during patient examination (See Lavin, Col.1, lines 58-62).

Claims 10, 13, 15-16, and 19-20 recite the underlying process steps of the elements of claims 2, 4, 6, 11 and 17 have been shown to be either disclosed by or obvious in view of the collective teaching of Montlick, Lavin, it is readily apparent that

the method disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 10, 13, 15-16 and 19-20 are rejected for the same reasons given above for claims 2, 4, 6, 11, and 17, and incorporated herein.

5. Claims 7, 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montlick (5,561,446) in view of Lavin et al (5,772,585) as applied to claims 1-6, 8-10, 12-13 and 15-23 above and further in view of Gershman et al (6,199,099).

As per claims 7, 11 and 14, Montlick and Lavin disclose the method wherein the code (See Montlick, Col.5, lines 10-20).

Montlick does not explicitly disclose that the method is transmitted using Wireless Mark-up Language (WML).

However, this feature is known in the art, as evidenced by Gershman. In particular, Gershman teaches a Wireless Mark-up Language (WML) which can also be a Wireless Application Protocol in order to view on handheld devices with small screens, such as cell phones (See Gershman, Col.1, lines 45-60).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature Gershman within the collective teachings of Montlick and Lavin with the motivation of providing WAP, a standard way to put data capability into wireless phones, and allowed carriers to do more over-the-air management (See Gershman, Col.1, lines 52-56).

### **Response to Arguments**

6. Applicant's arguments filed on 3/19/07 with respect to claims 1-23 are fully considered but they are not persuasive. Applicant's arguments will be addressed in the order in which they appear in the response filed on 3/19/07.

(A) At pages 8-9 of the 3/19/07 response, Applicant argues that the features in the 3/19/07 amendment are not taught by or suggested by the applied references.

In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 3/19/07 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Montlick, Gershman and Lavin based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the Office Action, and incorporated herein. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981), *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference, nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

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### Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769. The examiner can normally be reached on Monday-Thursday from 6:30 am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zeender Ryan Florian can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Vanel Frenel

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May 26, 2007